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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/518,091	12/16/2004	Giancarlo Cravotto	48239	5511
1609 7590 09/19/2007 ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036			EXAMINER CARR, DEBORAH D	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 09/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/518,091

**Applicant(s)**

CRAVOTTO, GIANCARLO

**Examiner**

Deborah D. Carr

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/07.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 is rendered indefinite because it contains duplicate information. Claim 17 reads as follows:

17. (Previously presented) Compounds selected from the group consisting of:

- octacos- 10, 19-dienoic acid,
- octacos- 10, 19,22-trienoic acid,
- octacos- 1,19,22,25-tetraenoic acid,
- 14,18,22-trimethyltricos- 10, 13,17,21 -tetraenoic acid,
- **primary alcohols of 18,19 octacosadiene, 10,19,20 octacosatriene, 1,19,22,25 octacosatetraene and 14,18,22 trimethyltricos 10,13,17,21 tetraene,**
- and C1-C4 alkyl ester of octacos- 10, 19-dienoic acid,
- octacos- 10, 19,22-trienoic acid,
- octacos- 1,19,22,25-tetraenoic acid,
- 14,18,22-trimethyltricos- 10, 13,17,21 -tetraenoic acid,

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- **primary alcohols of 18,19 octacosadiene, 10,19,20 octacosatriene, 1,19,22,25 octacosatetraene and 14,18,22 trimethyltricoso 10, 13,17,21 tetraene.**

The boldfaced print is where duplication occurs in the claim and should be deleted.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 13-16 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kocian et al. (CS 212049) or Kocian et al.

CN'049 teaches the instant invention when X is  $-\text{CH}_2\text{OH}$ ,  $R_1$  is 8,  $R_2$  is 19 and  $R_1 + R_2$  is 27. Kocian et al. teaches the instant invention when X is  $-\text{CH}_2\text{OH}$ ,  $R_1$  is 8,  $R_2$  is 19 (saturated & unsaturated hydrocarbon chain) and  $R_1 + R_2$  is 28.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 13-14, 16 rejected under 35 U.S.C. 102(e) as being clearly anticipated by Okawa et al. (US Pat. 6,656,662).

US'662 teaches the instant invention when X is  $-C(O)OH$ ,  $R_1$  is 8,  $R_2$  is 18 and  $R_1 + R_2$  is 26.

### *Claim Rejections - 35 USC § 103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 13-14, 16-19 rejected under 35 U.S.C. 103(a) as being unpatentable over Okawa et al (US Pat. 6,656,662) or Kocian et al. (CS 212049) in view of applicants disclosure on pages 7-9 or Cavazza (US Pat. 6,328,998).

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US'662 teaches the instant invention when X is  $-C(O)OH$ ,  $R_1$  is 8,  $R_2$  is 18 and  $R_1 + R_2$  is 26 and CN'049 teaches the instant invention when X is  $-CH_2OH$ ,  $R_1$  is 8,  $R_2$  is 19 and  $R_1 + R_2$  is 27. The references differ from the claims by not placing the compounds in a pharmaceutical, nutraceutical, dietetic integrator or cosmetic compositions in association with anti-oxidant vitamins, carnitine or its alkanoyl derivative.

It would have been obvious to one of ordinary art at the time the invention was made to include or place said instant compounds into the compositions listed supra. As shown in US'998 the class of compounds known as polycosanols is known to be used in pharmaceutical compositions. Also, applicants have stated it is conventionally known to use both polycosanols and polycosanoic acids in pharmaceutical, nutraceutical, dietetic integrator or cosmetic compositions in association with anti-oxidant vitamins, carnitine or its alkanoyl derivative.

Also, it is obvious to form salts and esters from known acids. And while a hydrocarbon chain containing 9 carbons is not exemplified, the claimed invention would have been obvious to the skilled artisan because close structural similarity of the reference compound suggest the claimed compound and would have similar properties.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637.

The examiner can normally be reached on Monday-Friday 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DEBORAH D. CARR  
PRIMARY EXAMINER

ddc